APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/692,152	10/22/2003	Hiroyuki Uno	P/2041-68	5875

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EXAMINER
KIM, WESLEY LEO

ART UNIT	PAPER NUMBER
2617	

DATE MAILED: 06/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	Applicant(s)
Office Action Summary	10/692,152	UNO, HIROYUKI
	Examiner	Art Unit	
	Wesley L. Kim	2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on <u>03 March 2006</u>.

2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) <u>1-9</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) <u>1-9</u> is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☒ The drawing(s) filed on <u>03 March 2006</u> is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

This Office Action is in response to Amendment filed on 3/3/06.

Claims 1, 5, and 9 are currently amended.

Claims 1-9 are pending in the current Office Action.

Response to Arguments

Applicant's arguments with respect to claims 1-9 have been considered

but are moot in view of the new ground(s) of rejection. The examiner notes that

the Kim (U.S. Patent 6882860 B1) reference was previously used and is used

once again in the current Office Action, however, Kim is now being used as a

secondary reference and not the primary reference.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or
> composition of matter, or any new and useful improvement thereof, may obtain a patent
> therefor, subject to the conditions and requirements of this title.

1. Claim 9 is rejected under 35 U.S.C. 101 because the claimed invention is

   directed to non-statutory subject matter.

   Claim 9 is found to be unpatentable under 35 USC 101 as being

nonstatutory. While the preamble recites "program causing a computer to

execute...", such claimed computer programs do not define any structural and

functional interrelationships between the computer program and other

claimed elements of a computer which permits the computer programs

functionality to be realized. In contrast, a claimed computer-readable medium

encoded with a computer program is a computer element which defines

structural and functional interrelationships between the computer program

and the rest of the computer which permit the computer programs

functionality to be realized, and is thus statutory. See Lowry, 32F.3d at 1583-

84, 32 USPQ2d at 1035. Accordingly it is important to distinguish claims that

define descriptive material per se from claims that define statutory inventions.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for

all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described
> as set forth in section 102 of this title, if the differences between the subject matter sought to
> be patented and the prior art are such that the subject matter as a whole would have been
> obvious at the time the invention was made to a person having ordinary skill in the art to which
> said subject matter pertains. Patentability shall not be negatived by the manner in which the
> invention was made.

1. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Nealon et al (U.S. Patent 5463659) in view of Kim (U.S. Patent 6882860 B1).

Regarding Claims 1, 5, and 9, Nealon teaches key inputting means

(Fig.2;260, keypad);

key inputting means including a plurality of keys for accepting a key

inputting operation of any of said keys by a user of said portable telephone

set (Col.5;33-37 and Fig.2;260);

key input discrimination means for discriminating whether the key

inputting operation of said key inputting means is valid or invalid (Fig.3;310-

Fig.3;311 and Fig.3;318-Fig.3;319, the phone determines if the key input is

valid or invalid so there is a key input discrimination means for discriminating

whether the key inputting operation of said key inputting means is valid or invalid);

key input validity notification means operable when said key input discrimination means discriminates that the key inputting operation is valid for causing said call termination notification means to notify the user of the validity of the key inputting operation with a first pattern set in advance (Fig.3;310-Fig.3;311, happy tone); said first pattern being different from a function performed by the key inputting operation (Fig.3;310-Fig.3;311, a happy tone is different from the key inputting operation); and

key input invalidity notification means operable when said key input discrimination means discriminates that the key inputting operation is invalid for causing said call termination notification means to notify the user of the invalidity of the key inputting operation with a second pattern set in advance and different from the first pattern (Fig.3;318-Fig.3;319, sad tone), however, Nealon **does not expressly teach** call termination notification means and said call termination notification means functioning to notify the user of termination of a telephone call in addition to functioning to notify the user of the validity or invalidity of the key inputting operation.

Kim teaches a call termination notification means (Col.2;67-Col.3;3 and Fig.1;117, a buzzer). Nealon must have a buzzer to produce the valid/invalid tone (Fig.3;310-Fig.3;311 and Fig.3;318-Fig.3;319) and to one of ordinary skill in the art, it is obvious that the said call termination notification means functions to notify the user of termination of a telephone call in addition to

functioning to notify the user of the validity or invalidity of the key inputting operation.

To one of ordinary skill in the art, it would have been obvious to modify Nealon with Kim such that the call termination notification means and said call termination notification means functions to notify the user of termination of a telephone call in addition to functioning to notify the user of the validity or invalidity of the key inputting operation, to provide a method of implementing the use of a single buzzer to produce all sounds, to keep the size of the phone as small as possible.

Regarding Claims 2 and 6, Kim teaches said call termination notification means includes a speaker or LCD display (Fig.1;117 and Col.2;65-67).

Regarding Claims 3 and 7, the combination as discussed above teach all the limitations as recited in claims 2 and 6, however the combination is silent on the liquid crystal display device of said call termination notification means is rendered operative when said portable telephone set is used in a mode wherein no sound is generated from said foldable telephone set.

Kim teaches that an LCD display displays different call termination displays (Col.2;65-67). To one of ordinary skill in the art, it is obvious that if a phone is in a mode where no sound is generated from the portable telephone set, another means of alerting the user must be used, i.e. vibration, or various displays via LCD display.

Regarding Claims 4 and 8, Nealon teaches a memory (Col.6;9-12)

and said key input discrimination means using the key allocation information

to discriminate whether the key inputting operation is valid or invalid (See

rejection of Claim 1), however Nealon **does not expressly teach** the memory

storing key allocation information representative of whether each of said keys

is valid or invalid when a selected menu is to be processed.

Nealon teaches in Fig.3;310-311, if keys 1-3 is pressed then a happy

tone will sound at the handset, to a skilled artisan, it is obvious that the

memory stores information representative of whether each of said keys is

valid or invalid when a selected menu is to be processed.

Conclusion

Any inquiry concerning this communication or earlier communications from

the examiner should be directed to Wesley L. Kim whose telephone number is

571-272-7867. The examiner can normally be reached on Monday-Friday

9:00am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the

examiner's supervisor, George Eng can be reached on 571-272-7495. The fax

phone number for the organization where this application or proceeding is

assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

WLK

GEORGE ENG
SUPERVISORY PATENT EXAMINER